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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,195	01/21/2004	Kia Silverbrook	RRA30US	2170

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER	
GARCIA JR, RENE	

ART UNIT	PAPER NUMBER
2853	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/760,195	SILVERBROOK, KIA	
	Examiner	Art Unit	
	Rene Garcia, Jr.	2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 July 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *08 November 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 10/760,186. Although the conflicting claims are not identical they are not patentably distinct from each other because it would be obvious to one skilled in the art that the existing elements and functions of claims 1 and 2 are within the above mentioned application (10/760,186) which pertains to an apparatus for dispensing printing fluid.

Claimed in application (10/760,186) is an apparatus for dispensing printing fluid. It contains a housing comprising first and second portions movable relative to each other; a reservoir of printing fluid responsive to relative motion of the first and second portions and having an outlet arranged to convey the printing fluid to a point external to the housing. It would have been obvious to one skilled in the art to incorporate a reservoir comprising a deformable container located within the housing and wherein bringing the first and second portions towards each other causes compression of said container and would have been obvious to one skilled in the art to utilize these elements for the purpose of conveying/egress/ the printing fluid from the dispenser (page 3, lines 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit including first and second portions with mated features arranged to prevent motion, for the purpose of not preventing motion between the housing portions. It has been held that omission of an element and its function would have been obvious if this feature

was not desired. **In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Elimination Of A Step Or An Element And Its Function.**

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The remaining claims 3-9 are objected to with respect to its dependency on the rejected claim.

Specification

2. The disclosure is objected to because of the following informalities: Page 9 line 7 makes reference to silicon wafer substrate "801", perhaps mean "8015".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao et al. (US 6,120,138).

Xiao et al. disclose the following claimed limitations:

*regarding claim 1, printing fluid/**ink, 10/** dispenser/**ink supply, 300/** including:

*housing/**300/** comprising first/**case, 310/** and second/**plunger, 330/** portions movable relative to each other (base/310/ includes cap/334/ which plunger/330/ moves through) (fig. 5)

*reservoir of printing fluid/**10**/ (space between piston/320/ and inner portion of case/310/) responsive to relative motion of the first/**310**/ and second/**330**/ portions and having an outlet/**nozzle, 314**/ arranged to convey the printing fluid/**10**/ to a point external/**cartridge, 400**/ to the housing/**300**/ (fig. 5; col. 3, lines 26-31)

*in use bringing the first/**310**/ and second/**330**/ portions towards each other causes egress of the printing fluid/**10**/ through the outlet/**314**/ (col. 3, lines 26-31)

*regarding claim 3, first/**case, 310**/ and second/**plunger, 330**/ portions of the housing/**ink supply, 300**/ are arranged to slide over each other (fig. 5; col. 3, lines 26-31 ; (base/310/ includes cap/334/ which plunger/330/ moves through)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (US 6,120,138) in view of Yuen (US 2004/0055661)

Xiao et al. does not disclose the following claimed limitations:

*regarding claim 2, reservoir comprises a deformable container located within the housing and wherein bringing the first and second portions towards each other causes compression of said container

Yuen disclose the following:

* regarding claim 2, reservoir comprises a deformable container/**ink pouch, 16/** (paragraph 0047 & 0048) located within the housing/**ink fill apparatus, 10/** and wherein bringing the first/**first housing member, 12/** and second/**second housing member, 14/** portions towards each other causes compression of said container/**16/** (figs. 4 & 5; paragraphs 0047 & 0048) for the purpose of permitting ink pouch to be essentially flattened to force ink into cartridge

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a reservoir comprises a deformable container located within the housing and wherein bringing the first and second portions towards each other causes compression of said container as taught by Yuen into Xiao et al. for the purposes of permitting ink pouch to be essentially flattened to force ink into cartridge.

7. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (US 6,120,138) as modified by Yuen (US 2004/0055661) as applied to claim 2 above, and further in view of Rossell (US 6,386,871) and Prausnitz et al. (US 2003/0208167).

Xiao et al. as modified by Yuen disclose the following claimed limitations:

*further regarding claim 7, first/**case, 310/** and second/**plunger, 330/** portions of the housing/**ink supply, 300/** comprise a base/**case, 310/** and plunger/**plunger, 330/** (Xiao; fig. 5)

Xiao et al. as modified by Yuen does not disclose the following claimed limitations:

*regarding claim 4, further including a resilient member disposed between the deformable container and either or both of the first and second portions of the housing

*regarding claim 5, resilient member has characteristics selected to limit pressure in the deformable container to a predetermined level in use

*regarding claim 6, resilient member comprises a spring

*regarding claim 8, spring is located between the deformable container and the plunger

*regarding claim 9, deformable container comprises a membrane

Rossell disclose the following:

*regarding claim 4, further including a resilient member/**spring, 11/** disposed between the deformable container/**space, 9/** and either or both of the first/**actuating piston, 10/** and second/**syringe, 5/** portions of the housing/**sealing device, fig. 1 & 2/** for the purpose of applying a given force to be supported by membrane

*regarding claim 5, resilient member has characteristics selected to limit pressure in the deformable container to a predetermined level in use for the purpose of (col. 4, lines 57-62) for the purpose of applying a given force to be supported by membrane

*regarding claim 6, resilient member/**spring, 11/** comprises a spring/**spring, 11/** (fig. 2) for the purpose of applying a given force to be supported by membrane

*regarding claim 8, spring is located between the deformable container and the plunger (fig. 2; spring is between plunger/actuating piston, 10/ and space/9/) for the purpose of applying force on the space/deformable bag/

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize including a resilient member disposed between the deformable container and either or both of the first and second portions of the housing; resilient member has characteristics selected to limit pressure in the deformable container to a predetermined level in use; resilient member comprises a spring; and spring is located between the deformable container and the plunger as taught by Rossell into Xiao et al. as modified by Yuen for the purposes of applying a given force to be supported by membrane.

Prausnitz et al. disclose the following:

*regarding claim 9, deformable container comprises a membrane/**sponge**/ (paragraphs 0033 & 0034)

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize deformable container comprises a membrane deformable as taught by Prausnitz et al. into Xiao et al. as modified by Yuen for the purpose of retaining the drug liquid until the material/membrane/ is compressed.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al. (US 6,120,138) in view of Yuen (US 2004/0055661) and Rossell (US 6,386,871).

Xiao et al. disclose the following claimed limitations:

*regarding claim 10, printing fluid/**ink, 10/** dispenser/**ink supply, 300/** including: (fig. 5)

*housing/**300/** comprising a base/**case, 310/** and a plunger/**plunger, 330/** (fig. 5)

*outlet/**nozzle, 314/** arranged to convey the printing fluid/**10/** to a point external/**cartridge, 400/** to the housing/**300/** (fig. 5; col. 3, lines 26-13)

*in use, bringing the plunger/**330/** towards the base/**310/** causes the egress of the printing fluid/**10/** through the outlet/**314/** (fig. 5; col. 3, lines 26-31)

Xiao et al. does not disclose the following claimed limitations:

*regarding claim 10, deformable container located within the housing for storing printing fluid

*spring located between the deformable container and the plunger having characteristics selected to limit pressure in the deformable container to a predetermined level in use

*in use, bringing the plunger towards the base causes compression of the deformable container between the spring and the base

Yuen disclose the following:

*regarding claim 10, deformable container/**ink pouch, 16/** (paragraph 0047 & 0048)located within the housing/**ink fill apparatus, 10/** for storing printing fluid/**ink/** (figs. 4 &5) for the purpose of permitting ink pouch to be essentially flattened to force ink into cartridge

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a reservoir comprises a deformable container located within the housing and wherein bringing the first and second portions towards each other causes compression of said container as taught by Yuen into Xiao et al. for the purposes of permitting ink pouch to be essentially flattened to force ink into cartridge.

Rossell disclose the following:

*further regarding claim 10, spring/**11/** located between the deformable container/**space, 9/** and the plunger/**actuating piston, 10/** having characteristics selected to limit pressure in the deformable container/**space, 9/** to a predetermined level in use (col. 4, lines 57-62) for the purpose of applying a given force to be supported by membrane

*in use, bringing the plunger/**actuating piston, 10/** towards the base/**syringe, 5/** causes compression of the deformable container/**space, 9/** between the spring/**11/** and the base/**syringe, 5/** (shown in fig. 2) purpose of applying a given force to be supported by membrane

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a spring located between the deformable container and the plunger having characteristics selected to limit pressure in the deformable container to a predetermined level in use; and bringing the plunger towards the base causes compression of the deformable container between the spring and the base as taught by Rossell into Xiao et al. for the purpose of applying a given force to be supported by membrane.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zepeda (US 5,886,719) disclose an ink refill system including a valve resembling a needle (plunger system). Allgeier, Sr. et al. (US 5,515,663) disclose a method to refill ink into an empty ink jet printer cartridge including a syringe (plunger).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rene Garcia Jr
07 November 2005

11/05
K. ROBBINS
PRIMARY EXAMINER